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REMARKS

Claims 1, 3-4, and 6-27 are pending in the present Application. Claim 4 has been canceled, leaving Claims 1, 3, and 6-27 for consideration upon entry of the present Amendment.

The Specification has been amended as explained in detail below. Support for the amendment can at least be found in Claim 1.

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1, 3, and 6-15 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. More particularly, the Examiner states that Applicants' use of the phrase "adjusted before" in the claims, "contains subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." (O.A., page 2).

Applicants have amended the specification at paragraph [0070] to include the phrase "adjusted before", which is employed in the claims, e.g., Claim 1. More particularly, paragraph [0070] has been amended to indicate that the terminal OH concentration of polycarbonate waste resin can be adjusted before being subjected to either of the transesterification reaction or the polycondensation reaction. Applicants respectfully submit that the claimed invention is described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1, 3, and 6-15 stand rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Published Patent Application No. 2003/0065130 to Hahnsen et al. Applicants respectfully traverse this rejection.

First, Applicants note that Claim 16 was not included in the above list of rejected claims.

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However, the Examiner on page 3 of the Office Action alleged that Hahnsen et al anticipates Claim 16. As such, Applicants respectfully traverse this rejection as well.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Hahnsen et al. teach that “the polycarbonate used either already has an average concentration of phenolic terminal groups over 100 ppm OH . . . or this is adjusted in the melt by adding a bisphenol . . . or oligocarbonates having terminal OH groups.” (emphasis added; paragraph [0018]). Hahnsen et al. goes on to teach that, “[w]hen converting in the melt to higher molecular weights, volative portions that are split off are discharged from the reactor as vapors.” (emphasis added; paragraph [0018]). Absent in Hahnsen et al. is any teaching (express or inherent) of adjusting the OH group concentration of the polycarbonate waste component, wherein the OH group concentration is adjusted before being subjected to either of the transesterification reaction or the polycondensation reaction.

Additionally, please note with regard to Applicants’ term “waste”, Applicants disclose that

polycarbonate resin waste means both reused/recycled polycarbonate once used as a part of a useful product that has been discarded, as well as reused/recycled plastic made from excess polycarbonate material or defective parts discarded during the manufacturing process. This excludes polycarbonate that has been recycled in the process of manufacturing the product. (Paragraph [0023]).

The Examiner states that “applicants term ‘waste’ is inclusive of the ‘recyclate’ since applicants process is recycling or continuous.” (O.A., page 3). Applicants respectfully submit that the term recyclate is determined by its context. It appears that the Examiner is equating the term “recyclate” to a loop reaction. (See O.A., page 3). For clarity of the record, Applicants respectfully disagree with any characterization of the term “waste” that would include “polycarbonate that has been recycled in the process of manufacturing the product” (Paragraph [0023]).

Further, Applicants respectfully disagree with the Examiner’s assertion that “depending upon ones perspective of the continuing process [of Hansen et al.] could be considered before, during, or after either the transesterification or melt polycondensation, i.e., it is in a loop reaction.” More particularly, Applicants respectfully disagree with the Examiner’s use of the

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term recycle to include a loop reaction. With regard to the use of the term “recyclate” by Hansen et al., Applicants respectfully request a showing by the Examiner where Hansen et al. teach a loop reaction. Hansen et al. teach a “PC recycle from Compact Discs” (Paragraph [0035]), and PC recycle from “consumption waste and process scrap” (Paragraph [0035]). In other words, it is not clear from Hansen et al. that they teach adjusting the OH group concentration of the polycarbonate waste component, wherein the OH group concentration is adjusted before being subjected to either of the transesterification reaction or the polycondensation reaction. As such, Hansen et al. fail to teach or suggest at least one element of Applicants’ independent Claim 1. Accordingly, independent Claim 1 is not anticipated and is therefore allowable over Hansen et al. Moreover, as dependent claims from an allowable independent claim, Claims 3, 6, and 7-15 are, by definition, also allowable.

With regard to Claim 16, the Examiner alleged “the use of a mixing tank is with no specific characteristics etc. is considered to be anticipated by the art since a mixing tank is used therein.” (Office Action, page 3).

First, it is noted that Hahnsen et al. fail to teach “introducing a dihydroxy compound and a carbonate diester to a mixing tank to form a mixing tank composition,” nor does the reference teach “combining the prepolymerization composition with the melted polycarbonate waste component to form a combination.” Rather, Hahnsen et al. teach a process where at least one member of “aromatic (co)polycarbonate production, waste of (co)polycarbonate production, remainders of (co)polycarbonate production and (co)polycarbonate recyclate” are melted in a vessel to form a melt. (Abstract).

Stated another way, Hahnsen et al. is silent on a process that makes a new polycarbonate from a prepolymerization composition that is combined with a melted polycarbonate waste component. (See Applicants paragraph [0023]). At best, Hahnsen et al. teach making polycarbonate by melting existing (used/recycled) polycarbonate. For at least the reason that Hahnsen et al. fail to teach the claimed elements relating to forming a prepolymerization composition and combining the prepolymerization composition with melted polycarbonate resin waste, Applicants’ independent Claim 16 is not anticipated and is allowable over Hahnsen et al. Moreover, as dependent claims from an allowable independent claim, Claims 17-27 are, by

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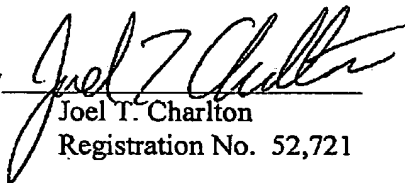
definition, also allowable.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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